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Paper 1  
Declared: 20 February 2009

UNITED STATES PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS AND INTERFERENCES

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Patent Interference 105,685 McK  
Technology Center 1600

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ANTHONY F. HADFIELD, SYED M. SHAH,  
MICHAEL W. WINKELY, KAREN W. SUTHERLAND,  
JAMES A. PROVOST, AERI PARK, REX A. SHIPPLETT,  
BRENTON W. RUSSELL and BEAT T. WEBER

Patent 6,673,838 B2,  
Junior Party,

v.

THOMAS P. JERUSSI, CHRISANTHA H. SENANAYAKE  
and NANDKUMAR N. BHONGLE,

Application 10/720,134,  
Senior Party.

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Before: Fred E. McKelvey, *Senior Administrative Patent Judge.*

DECLARATION

1 Part A  
2 Declaration of Interference  
3

4 An interference is declared pursuant to 35 U.S.C. § 135(a).

5 Details of the application, patent, count and claims designated  
6 as corresponding or as not corresponding to the count appear in  
7 Parts E and F.

8  
9 Part B  
10 Designation to manage  
11

12 Senior Administrative Patent Judge Fred E. McKelvey has been  
13 designated to manage the interference. 37 CFR § 41.104(a).

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15 Part C  
16 Standing Order  
17

18 A copy of a STANDING ORDER (3 Jan. 2006) (Paper 2)  
19 accompanies this DECLARATION.

20 The STANDING ORDER applies to this contested case.

21 Part D  
22 Initial Conference Call and Motions Lists  
23

24 Conference Call

25 A conference call to set dates for action in this contested case  
26 is scheduled for:

27 2:00 p.m. (1400 hours Eastern Time) on 1 April 2009.

28 The Board will initiate the conference call.  
29

1 Motions Lists

2 On or before:

3 Noon (1200 hours Eastern time) on 26 March 2009,  
4 each party shall file, and on or before:

5 5:00 p.m. (1700 hours Eastern time) on 26 March 2009,  
6 each party shall serve a notice stating the relief the party requests,  
7 *i.e.*, a motions list including motions the party seeks authorization to  
8 file. 37 CFR §§ 41.120(a) & 41.204; STANDING ORDER ¶¶ 104.2.1,  
9 120 & 204.

10 The default procedure for filing and serving motions lists is that  
11 motions lists are to be *filed* before being *served*.

12 By filing before service, one party will not have access to an  
13 opponent's motions list prior to the filing of the party's motions list.

14 Nevertheless, the parties may mutually agree to discuss and  
15 serve motions lists at any time prior to the date and time motions lists  
16 are due.

17 The following shall be included in motions lists.

18 (1) Proposed motion for benefit (*i.e.*, to be accorded an  
19 earlier constructive reduction to practice) must identify the  
20 application(s) for which benefit will be sought.

21 (2) Proposed motion to attack benefit must identify the  
22 application(s) to be attacked.

23 (3) Proposed motion seeking judgment against an  
24 opponent based on alleged unpatentability must identify the statutory  
25 basis for the alleged unpatentability and:

26 (a) if based on prior art, identify the prior art;

1 (b) if based on the first paragraph of 35 U.S.C.  
2 § 112, (i) identify whether written description, enablement or best  
3 mode will be the basis for the motion, and (ii) briefly identify the basis  
4 for any alleged unpatentability;

5 (c) if based on an alleged failure to comply with  
6 35 U.S.C. § 135(b), briefly identify the reason;

7 (d) if based on the second paragraph of 35  
8 U.S.C. § 112, identify the limitation which is believed to be indefinite.

9 (4) Proposed motion based on no interference-in-fact  
10 shall briefly identify the reason no interference-in-fact is believed to  
11 exist.

12 (5) Proposed motion to designate additional claims as  
13 corresponding to a count or as not corresponding to a count shall  
14 identify the claims involved.

15 (6) Proposed motion to add or substitute a new count  
16 shall explain why the added or substitute count is necessary.

17 A motions list shall not contain any "reservation clause"  
18 whereby a party purports to reserve a right to file additional motions.  
19 Additional motions are those authorized by the Board consistent with  
20 the rules.

21 A sample schedule for taking action during the motions phase  
22 of the interference appears as Form 2 (page 69) of the STANDING  
23 ORDER.

24 Counsel are encouraged to discuss the schedule prior to the  
25 conference and agree to on times for taking action generally  
26 consistent with the sample schedule.

27 A typical motions phase last about eight (8) months.

- 1           The parties should be prepared at the conference to justify any
- 2 request for shorter or longer time periods.

3

1 Part E

2  
3 Identification of the Parties  
4 Assignment of Exhibit Numbers  
5 Initiating Settlement Discussions  
6

7 Junior Party

8  
9 Inventors: Anthony F. Hadfield, NY  
10 Syed M. Shah, NJ  
11 Michael W. Winkley, NY  
12 Karen W. Sutherland, NY  
13 James A. Provost, UK  
14 Aeri Park, IN  
15 Rex A. Shipplett, IN  
16 Brenton W. Russell, IN  
17 Beat T. Weber, CH  
18  
19 Patent: U.S. Patent, 6,673,838 B2  
20 granted 6 January 2004  
21 based on application 10/073,743,  
22 filed 11 February 2002  
23  
24 Title: Succinate salt of O-desmethyl-venlafaxine  
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26 Real party in interest: Wyeth  
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1 Part F  
2 Count and Claims of the Parties  
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4 The compound of claim 1 of Hadfield

5 or

6 The compound of claim 60 of Jerussi.

7  
8 Hadfield claim 1 reads:

9 A compound which is O-desmethyl venlafaxine succinate.

10 Jerussi claims 60 reads:

11 A compound which is O-desmethylvenlafaxine succinate.

12  
13 The claims of the parties are:

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15 Hadfield: 1-46

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17 Jerussi: 60-71

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19 The claims that correspond to Count 1 are:

20  
21 Hadfield: 1-3 23-30 and 33-34.

22  
23 Jerussi: 60-71

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25 The claims that do not correspond to Count 1 are:

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27 Hadfield: 4-22, 31-32, and 35-46

28  
29 Jerussi: None  
30



1           The parties are accorded an earlier constructive reduction to  
2 practice (*i.e.*, benefit for the purpose of priority) of the following  
3 applications:

4                   Hadfield:   None

5

6                   Jerussi:    Application 09/527,442,  
7                                filed 17 March 2000

Part G  
Heading to be Used on Papers

The following heading shall be used on all papers filed in this  
interference [STANDING ORDER ¶ 106.11 (Paper 2, page 20)].

Filed by: [name of party] Paper \_\_\_\_  
[Name of attorney] Date filed: [enter date emailed to Board]  
[Email address of attorney]  
[Telephone number of attorney]

UNITED STATES PATENT AND TRADEMARK OFFICE  
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Patent Interference 105,685 McK  
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Application 10/720,134,  
Senior Party.

Title of Paper, *e.g.*, [Name of party] MOTION 1

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Part H  
Order Form for Requesting File Copies

When requesting file copies, a party shall use STANDING  
ORDER Form 4 (page 71).  
Use of form 4 will expedite processing of any request.  
a party should attach to any request for file copies a photocopy  
of Part E (for involved files) and Part F (for benefit files) of this  
DECLARATION with a hand-drawn circle around the patent and  
application files for which a copy of a file wrapper is requested.  
The parties are advised that a single order for file copies may  
be filled by the Office of Public Records at more than one time.  
STANDING ORDER ¶ 109.2 (Paper 2, pages 25-27).

1 Part I  
2 Required Paragraph of Affidavits and Declarations  
3

4 The Board has experienced cases in which a witness has  
5 belatedly advanced reasons why the witness would be unable to  
6 appear for cross examination at a reasonable time and place in the  
7 United States.

8 Consequently, to prevent surprise and hardship to the party  
9 relying on the testimony of a witness, the following paragraph must  
10 be included on the signature page of all affidavits (including  
11 declarations) filed in this case. STANDING ORDER ¶ 157.2 (Paper  
12 2, pages 52-53).

13  
14 In signing this affidavit, I understand that the affidavit will  
15 be filed as evidence in a contested case before the Board  
16 of Patent Appeals and Interferences of the United States  
17 Patent and Trademark Office. I also acknowledge that I  
18 may be subject to cross examination in the case and that  
19 cross examination will take place within the United States.  
20 If cross examination is required of me, I will appear for  
21 cross examination within the United States during the  
22 time allotted for cross examination.

1 (via electronic mail):

2 Attorney for Jerussi  
3 (real party in interest Sepracor Inc.):

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23 Attorney for Hadfield  
24 (real party in interest Wyeth):

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